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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,774	01/22/2001	Young Ho Yoo	2566.2.27	8347

21552 7590 09/12/2003

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EXAMINER

PETERSON, KENNETH E

ART UNIT PAPER NUMBER

3724

DATE MAILED: 09/12/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/766,774

Applicant(s)

YOO, YOUNG HO

Examiner

Kenneth E Peterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11 is/are pending in the application.
- 4a) Of the above claim(s) 3-5, 7, 8 and 11 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2 is/are allowed.
- 6) ☒ Claim(s) 1, 6 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

1. The disclosure is objected to because of the following informalities:

The term "groove", found in amended claims 1, cannot be found in the specification. This term should be added to provide proper antecedent basis. The term "groove" is not new matter, because one of ordinary skill would be able to infer it's presence from the drawings and from page 4, lines 11 and 12 of the specification.

Appropriate correction is required.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Todisco et al., who shows a buffer plate (50 plus plate above it) having a groove with an elastic member (60) and plurality of pins (30) sticking thru a guide plate (plate below the buffer plate). As required by claim 1, there "contact between *one* of the pins and the elastic member".

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Todisco., who shows all of the recited limitations except the resilient member is made of one piece rather than two. However, the courts have ruled that "the unity or diversity of parts would depend more on the choice of the manufacturer...than on any inventive concept" In re Lockhart, 90 USPQ 214. In this case, there appears to be no inventive concept to make it out of one piece or two. It would have been obvious to one of ordinary skill in the art to have made the resilient member out of two pieces, as a simple manufacturing choice.

Todisco obviously must have some sort of "fixation member" for supporting the buffer plate, but Todisco does not mention a grooved fixation member. The Examiner takes Official Notice that it is well known to hold a tool using a grooved fixation member, as broadly claimed. It would have been obvious to one of ordinary skill in the art to have modified Todisco by providing a grooved fixation member, as is well known, in order to hold the tool.

6. Claim 2 is allowed.

7. Applicant's arguments have been fully considered but they are not persuasive.
Applicant has overcome the 112 rejection.

Applicant argues that Todisco does not show a groove having an elastic member. Todisco does show, in the cover figure, a groove receiving an elastic member (60). The groove is not as long as Applicant's groove, but it is a groove nonetheless.


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One way that Applicant could overcome this rejection is to claim that a plurality of pins contact said elastic member.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth Peterson whose telephone number is 703-308-2186. The examiner can normally be reached on Monday-Thursday, 7:30-4:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached at 703-308-1082.

All responses are encouraged to be by fax at 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

kp
09 sep 03



KENNETH E. PETERSON
PRIMARY EXAMINER